



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,710	03/22/2004	Jason Goldsmith	JGO1A-H79	5961

.7590

06/28/2005

Karl M. Steins
Steins & Associates
Suite 120
2333 Camino del Rio South
San Diego, CA 92108

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
----------	--------------

3711

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,710

Applicant(s)

GOLDSMITH, JASON

Examiner

Sebastiano Passaniti

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is responsive to communication received 03/02/2005
Amendment (unsigned); 04/14/2005 – Amendment (signed).

The terminal disclaimer received 03/02/2005 has been approved and made of record.

Claims 1-18 remain pending.

Following is an action on the MERITS:

Claim Rejections - 35 USC § 102 and 35 USC §103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 8, 12, 13, 14, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaise (of record). As to claim 1, note head (1) including top surface (2) and face (3) along with a projection surface (not numbered) upon which an alignment image (7) is inscribed. Plate (5) serves as the claimed dome having a top and bottom surface, with the bottom surface thereof spaced from the projection surface. As to claim 2, the dome (5) includes a slot or window (6). As to claim 3, the slot (6) is

Art Unit: 3711

aligned generally perpendicular to the plane of the face , as shown in Figure 1. As to claim 4, note that the alignment image (7) is on the projection surface, while the slot or window (6) contains a plurality of lines (8, 9, 10) that may be placed in alignment with the inscribed alignment image. As to claim 5, Figure 2 shows the coplanar arrangement between the dome and the upper surface of the head. As to claim 7, the alignment image, the projection surface and the slot or window are all designed to be in alignment with one another. As to claim 8, the slot or window (6) defines a line that is perpendicular to the pane of the face. As to claims 12-14, see the remarks for claims 1-5, 7 and 8, supra. As to claims 16 and 18, note that plural lines may be provided on the upper surface (Figures 4(a), 4(b)).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaise. Although Kaise does not specifically detail a "lightened portion", the skilled artisan would have found it obvious to modify the Kaise reference to include any alternative and suitable indicia on the top surface and the projection surface, so long as the inventive concept of the Kaise invention is maintained. In fact, Kaise even suggests that other combinations of graphics may be used (col. 4, line 59 through col. 5, line 3).

Claims 1, 2, 3, 6, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamilton (of record). As to claim 1, note putter head (22) including a dome or central raised aligning portion (21) having a top surface (not numbered) within which a slot (20) is formed. An alignment image, i.e., a fluorescent surface or line is formed on projection surface (32). Surface (40) may be considered to be a bottom of the dome and, according to Figure 4, is indeed spaced from projection surface (32). As

Art Unit: 3711

to claim 2, note slot (20). As to claim 3, the slot is aligned along a line that is perpendicular to the plane of the face. As to claim 6, the raised aligning portion (21) includes a natural void (Figure 4). As to claim 7, the slot is aligned with the projection surface such that a line formed by the fluorescent texture on the projection surface in combination with the slot form a parallax alignment line. As to claim 8, the slot is defined generally along a line that is perpendicular to the face plane.

Claims 9-11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Innes in view of Hamilton and Kaise. The patent to Hamilton differs from the claimed invention in that Innes does not show indicia on a projection surface. In this case, central area (12) of Innes may serve as the claimed projection surface. Both Kaise and Hamilton show it to be old in the art to provide an alignment system in which vertically spaced apart indicia are used to form an alignment image that is arranged generally perpendicular to the face plane. Each of Kaise and Hamilton suggests that the indicia may include diverse graphics. Hamilton further provides for coloring of the projection surface (32) to produce a "lightened" appearance. In view of the patents to Kaise and Hamilton, it would have been obvious to modify the device in the cited art reference to Innes by providing the surface directly below sighting groves (16) with an alignment image, the motivation being to provide vertical spaced apart indicia for enhancing the alignment characteristics of the head.

Claim Rejections - 35 USC § 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection.**

As to claim 1, the bottom surface of the dome has not been adequately defined in the specification. Is the applicant referring to an arrangement as shown in Figures 10A and 10B in which the elongated bar includes a top surface and a bottom surface?

As to claim 9, the first and second club-head-attachable ends have not been adequately defined in the specification. Here again, is the applicant referring to an arrangement as shown in Figures 10A and 10B in which the elongated bar includes a top surface and a bottom surface?

As to claim 12, the first and second faces of the elongate bar have not been adequately defined.

Note, the dependent claims likewise share the deficiency of the independent claims.

Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language in claim 6 would appear to be inaccurate. Note, claim 6 depends from claim 3, which depends from claim 2, which depends from claim 1. If the "bottom surface" of the dome is spaced from the projection surface (claim 1), then it is not understood how the void that is within the dome is bounded on the bottom by the projection surface. If the bottom of the dome is in "spaced relation to the projection surface" (claim 1), how can the void be bounded on its bottom by the projection surface?

RESPONSE TO ARGUMENTS

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

FURTHER COMMENTS

It is noted that the applicant's remarks on page 5 of the 04/14/2005 response requests clarification with respect to the obviousness-type double patenting rejection that was set forth in the non-final Office action of 11/05/2004. Here, the fact that the Office action set forth a rejection based upon a judicially created doctrine of obviousness-type double patenting should in and of itself be sufficient to explain the grounds of rejection. There is no need to further stipulate that the "in view of Gibson"

Art Unit: 3711

set forth in the 11/05/2004 rejection is to be considered as a rejection under 35 U.S.C. §103. Further guidance for the applicant explaining the format used by the Office to style these types of rejections may be found in MPEP §804(B)(1). In any event, the filing and acceptance of the terminal disclaimer, received 03/02/2005, renders this matter moot.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

Art Unit: 3711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp
June 24, 2005


Sebastiano Passaniti
Primary Examiner